



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/933,951    09/19/97    TALTON    D    341/4

LM02/0930

KENYON AND KENYON  
WILLIAM K WELLS JR  
1025 CONNECTICUT AVENUE  
SUITE 600  
WASHINGTON DC 20036

EXAMINER

SAINT SURIN, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2747

DATE MAILED:

09/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/933,951**

Applicant(s)

**David Talton**

Examiner  
**Jacques M. Saint-Surin**

Group Art Unit  
**2747**



☒ Responsive to communication(s) filed on Jul 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-25 is/are allowed.

☒ Claim(s) 26-31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2747

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is responsive to the amendment of 7/6/99.
2. The 35 U.S.C 251 rejection is moot in view of the Supplemental Declaration of 07/06/99

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winebaum (US Patent 4,941,172) in view of Hosterman (US Patent 4,636,123).

Regarding claim 26, Winebaum ('172) discloses an electronic card sized direct dialing device that comprises:

a case of size and shape (compact credit "card" type housing, Figs. 3 and 10); an output unit (speaker 24) disposed in the case and outputting a first signal identifiable by a telephone network as a telephone number (DTMF generator 38 decodes a preprogrammed telephone number under control of program control software and generates a sequence of corresponding DTMF tones); an input unit disposed in the case and receiving an available access signal and a request signal from the telephone network (when switch 26 is actuated, (Fig. 4, block 100)

Art Unit: 2747

microprocessor 32 reads data representing a telephone number stored in ROM 34, (for example, 1-800-123-4567) at block 104 and applies the first value in the string to DTMF generator 38 (block 106) and DTMF generator 38 produces the DTMF tone pair corresponding to the first value for a time period controlled by microprocessor 32 (block 108) and subsequently causes to produce the tone pair) see: Fig. 4, col. 6, lines 60-68, col. 7, lines 1-6; a bus disposed in the case (connection between the microprocessor and ROM 34 and RAM 36, fig. 3); a processor (microprocessor 32) disposed in the case and coupled to the output unit and the input unit via the bus; said input (speaker 24) receiving access data and storing the access data in memory (ROM 34) ; said processor retrieving the access data from memory (microprocessor 32 reads data representing a telephone number stored in ROM 34, for example 1-800-123-4567 at block 104) and sending them to the telephone network in response to detecting the available access signal (and applies the first value in the string to DTMF generator 38 (block 106) and DTMF generator 38 produces the DTMF tone pair corresponding to the first value for a time period controlled by microprocessor 32 (block 108) and subsequently causes to produce the tone pair) see: Fig. 4, col. 6, lines 60-68, col. 7, lines 1-6. Note that Winebaum teaches, alternatively, the automatic dialing device may be incorporated into customized service cards such as personal business cards, long distance dialing cards (for dialing phone company access or charge numbers), credit cards and the like. However, Winebaum does not disclose an electronic credit card sized dialing device to be inserted into a computer. Hosterman ('123) discloses a credit card reader which provides an input signal indicated by numeral 16 to a digital computer 18 where the signal is processed to determine

Art Unit: 2747

validity which may send a return signal 20 back to the reader signaling further readout or authorizing actuation of the dialer 14 which then can send a signal 22 into the computer for transmission via signal 24 to effect a telephone call (see: col. 2, lines 38-46). Therefore, it would be obvious to one of ordinary skill of the art at the time of the invention to incorporate in Winebaum the credit card reader of Hosterman as taught above because it would have been obvious to incorporate a credit card reader with automatic dialing equipment to give the telephone a greater flexibility, versatility and eliminate operator intercepts to complete long distance calls and record billing and pertinent information pertinent.

Regarding claim 27, as discussed above, it is rejected for the reasons set forth for claim 26. Furthermore, Winebaum in view of Hosterman teaches that the duration of the tone pair produced by DTMF generator 38 should be sufficient to enable the telephone company switch tone decoders to properly detect and decode the tone pair (see: col. 7, lines 6-10).

Regarding claim 28, Winebaum in view of Hosterman teaches the transmission of audible signals from the dialer (chip 20) to a telephone handset (telephone handset 46, 48, Fig. 3) to access the telephone network and receiving audible signals (speaker 24) from the telephone handset with the dialer (chip 20, Fig. 3).

Regarding claim 29, Winebaum in view of Hosterman teaches microprocessor 32 which reads data representing a telephone number stored in ROM 34, for example 1-800-123-4567 at block 104) and storing at least temporarily the access data in memory (RAM 36, Fig. 3) of the dialer (chip 20).

Art Unit: 2747

Regarding claim 30, Winebaum in view of Hosterman discloses in Fig. 9 a specific telephone number is provided by a phone company (block 120) and programmed into microprocessor chip (block 122)

Regarding claim 31, Winebaum in view of Hosterman teaches decision block (110) at which tones corresponding to the entire predetermined telephone number will have been produced by speaker 24 and acoustically coupled to the telephone line via handset microphone 48 (see: col. 7, lines 21-29.

*Allowable Subject Matter*

5. Claims 1-25 are allowable over the prior art of record.

*Response to Arguments*

6. Applicant's arguments with respect to claims 26-31 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harris et al. (US Patent 4,447,676) discloses an automatic dialer for telephone network access control.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques M. Saint-Surin whose telephone number is (703) 305-4760. The examiner can normally be reached on Mondays through Thursdays from 8:30 A.M. to 6:00 P.M.

Art Unit: 2747

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen, can be reached on (703) 305-4386. The fax phone number for this Group is (703) 308-5403.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-5403, (for formal communications intended for entry)

**Or:**

(703) 305-3900 [1] (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

**JACQUES SAINT-SURIN**  
**PATENT EXAMINER**

Jacques M. Saint-Surin  
September 25, 1999



**FORESTER W. ISEN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2700**